

“general allegations” are insufficient to establish an actual reduction to practice, Mr. Freedman’s declaration, in contrast, provides much more, namely, explicit proof that the software components were built, tested and worked; these averments constitute “a statement of facts demonstrating the correctness of [the] conclusion [regarding actual reduction to practice].” MPEP §715.07(d).

- (b) There is no requirement that a Rule 131 declaration include the actual software components that were written and tested at the time. If the rule were otherwise, no Rule 131 declaration could ever be used to swear behind a reference absent submission of an actual physical embodiment. The Office has no procedures or logistics for handling such materials, and the patent owner here has an interest in maintaining its physical software. Thus, the fact that Mr. Freedman’s declaration did not include (e.g., as attachments) the physical software components that were built and tested at the time is not material to the question of whether the declaration establishes an actual reduction to practice, which it does.
- (c) Tab C was cited merely to corroborate the fact that the testing referred to by Mr. Freedman had taken place, in this case, on or about December 1, 2000. In other words, Tab C, per se, was not offered to show “a working invention” as the Examiner contends; rather, the data set was submitted to show that the software components identified by Mr. Freedman - and as described in Tab A - had been tested.
- (d) Tabs D and E were specific router configurations that were written and tested for the claimed “apparatus.” In this regard, the Examiner is reminded that these configurations are relevant to certain claim limitations, e.g., the last step of claim 10 directed to “automatically logging into the router and entering a new configuration to cause the router to reevaluate all routes heard from the selected transit autonomous system according to the new configuration.” (See, also, claim 1, last clause, claim 13, last clause). Mr. Freedman’s declaration included these configurations once again simply to corroborate his earlier statements – as described in Tab A – that the identified software components had been built, tested, and operationally verified. The Examiner’s unsupported conclusion that the “configurations are [not] executable to show that the apparatus worked for its

intended purpose” misses the point. As the above claim language emphasizes, the configurations are just a feature of the claimed invention; they were never intended, in of themselves, to comprise a working “apparatus.” But, the fact that these configurations existed at the relevant time shows that Mr. Freedman’s key conclusions (regarding building, testing and verification) are sound.

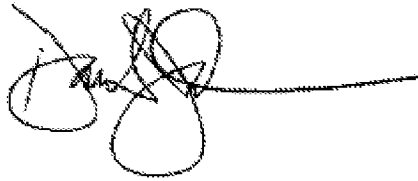
- (e) The conclusion that “Tabs A-E amount[] to no more than a mere allegation that the invention was reduced to practice” is incorrect. The most important aspects of Mr. Freedman’s declaration – namely, that the “software components” had been built and tested long before May 1, 2001, and that these components worked for their intended purpose – are unrebutted.
- (f) Mr. Freedman’s declaration establishes unequivocally a 1:1 correspondence between the claim language and the software components that he says were built, tested and shown to work for the intended purpose before May 1, 2001. The other documents (Tab C, D and E) verify that this testing, in fact, took place, once again prior to the May 1, 2001 date in question. Tab B is a further written corroboration that the invention had been built and tested and shown to work prior to this date. The only aspect of the reduction to practice that is not included in this showing is the actual code itself, and there is no requirement that the code must be provided, especially where the inventor’s statements are not contradicted and are supported by contemporaneous documentation (Tabs B-E).

The Examiner is requested to reconsider the refusal to accept the Freedman declaration and to withdraw Myers et al.

For the reasons previously advanced, the Myers et al. application is not prior art to the present invention. The Freedman declaration establishes that the subject invention was conceived and actually reduced to practice in this country at least as early as November 22, 2000. Supporting documentation regarding Mr. Freedman’s testing allegations is attached to the declaration. Accordingly, because Myers et al. is not prior art, no pending claim is subject to any sustainable (i.e. prima facie) case of obviousness.¹

¹ Once again, the undersigned does not concede that the Examiner’s interpretation of either Myers et al. or Halme is correct; nevertheless, because at least Myers et al. is not prior art (and no

Respectfully submitted,

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By: _____
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prima facie case of obviousness has been established), these arguments are not presented at this time. The Applicant reserves the right to address these issues if necessary later.